

REMARKS

Claims 8 and 10 are being amended to correct plain typographical errors, so that the subject/verb pair “ones/are” are in agreement with each other. No new matter has been added, and the claim scope has not been narrowed. Note that, throughout the claims, use of the plural “ones” is intended to encompass situations in which only “one” single item or member satisfies the condition or requirement.

The restriction requirement affecting claims 22-30 was previously made final, and so the above amendments cancel those withdrawn claims 22-30 without prejudice to put the application in better condition for allowance. Applicant reserves the right to pursue those claims in a later divisional application. After entry of this amendment, claims 1-21 will be pending in the application.

Reconsideration and continued prosecution of this application is respectfully requested.

The Office Action indicated claims 4 and 5 contain allowable subject matter. Applicant thanks the Examiner for this indication, but declines at this time to rewrite these claims in independent form because of the allowability of base claim 1, as explained below.

§ 103 Rejections

The Office Action rejected claims 1-3 and 6-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2003/0096628 (Bar-On et al.) in view of U.S. Patent 6,975,873 (Banks et al.). These rejections cannot be sustained.

Independent claim 1

In connection with claim 1, the Examiner asserted that “Banks teaches defining criteria using a mobile terminal, the criteria being used to determine minimum capabilities required of group attendees (col. 8, line 61 – col. 9, line 15)”, and that it would have been obvious “to provide the teaching of Banks into the system of [Bar-On] in order to track the relative location of mobile stations [belonging] to a pre-defined group of mobile stations”.

The Examiner is mistaken regarding the teachings of Banks, and at least for this reason the rejection of claim 1 and its dependent claims 2, 3, and 6-9 cannot be sustained.

Claim 1, and the other independent claims subject to this rejection, relate in some fashion to a criterion pertaining to a *capability* of a plurality of terminals. (Claim 1 recites “criteria ... used to determine minimum capabilities required of group attendees”; claim 10 refers to a server adapted to “compare ... capability information associated with each of the plurality of mobile terminals to the group member criteria”; claims 14, 19, and 21 recite “a terminal capability criterion”; and claim 16 recites “defining criteria to establish minimum capabilities of the group of mobile terminals”). Such terminal capabilities are distinct from location-related information or other information about the terminal. Examples of terminal capabilities given in the specification include, for example, whether a terminal has streaming capability (page 15, lines 11-12), or whether it is gaming enabled (page 15, line 14).

The undersigned has carefully read the cited portion of Banks, and also reviewed other portions of Banks, and can find no teaching of any terminal capability criterion as set forth in rejected claim 1. Banks relates generally to systems and methods of tracking locations of mobile stations included in a *pre-defined* group. (See e.g. Banks at col. 1 lines 1-4 (the title), col. 1 lines 14-20, and col. 2 lines 22-25.) The paragraph extending from column 8, line 61 to column 9, line 15 of Banks discusses *location-related* characteristics of mobile stations (for example: “... the processor may determine the present location of each mobile station ...”; “... processor 220 may determine whether each mobile station is within the identified area of interest and/or if the mobile stations 121-125 adhere to the preset minimum and/or maximum distances”; “... may determine a travel time that the users may have to reach a location so that their corresponding mobile stations 121-125 will be in compliance”), not any terminal capability criterion as set forth in rejected claim 1.

The Office Action acknowledges that Bar-On also fails to teach defining criteria using a mobile terminal, the criteria being used to determine minimum capabilities required of group attendees.

Since neither Bar-On nor Banks teaches “criteria ... used to determine minimum capabilities required of group attendees” as set forth in claim 1, it is axiomatic that the combination of Bar-On and Banks cannot yield a *prima facie* obviousness rejection under

35 U.S.C. § 103. See MPEP §§ 2142, 2143, 2143.03. The rejection of claim 1 and its dependent claims 2, 3, and 6-9 should be withdrawn.

Independent claim 10

The Office Action rejected claim 10 as obvious over the same references, Bar-On and Banks. The Examiner cited FIGS. 1 and 2 of (apparently) Bar-On and FIG. 3 of Banks in support of the rejection, alleging that “Banks teaches ... the group management server adapted to compare ... capability information associated with each of the plurality of mobile terminals to the group member criteria”. This rejection too cannot be sustained.

Despite the reference to FIG. 3 of Banks, the undersigned cannot find any teaching in Banks of a server adapted to “compare ... capability information associated with each of the plurality of mobile terminals to the group member criteria” as set forth in claim 10. Figure 3 of Banks is a flowchart showing a group-tracking method. Other than the starting point, all of the depicted steps relate to location-related information such as tracking information, location coordinates, location criteria, location-related notifications/alerts, and the like. The group list is said to be “pre-defined”, with no indication that the server is adapted to perform the capability-related comparison set forth in claim 10. Since neither Banks nor Bar-On teach a system with such a feature, the combination cannot render claim 10 obvious and the rejection of claim 10 and its dependent claims 11-13 should be withdrawn.

Independent claim 14

The Office Action rejected claim 14 as obvious over the same references, citing paragraph 074 of Bar-On and column 9, lines 25-41 of Banks in support of the rejection, alleging that “Banks teaches ... a terminal capability criterion (display and alert the user the location of other mobile terminal)”. This rejection cannot be sustained.

The cited passage of Banks states only that the subscribers/users “may be alerted”, without specifying any manner or mode of providing such an alert. Thus, Banks fails to teach a mobile terminal having a processor configured to enable a group criteria definition, including a terminal capability criterion, to be used in qualifying mobile terminals to participate in a group session as set forth in claim 14. Since neither Banks nor Bar-On

teach a mobile terminal with such a feature, the combination cannot render claim 14 obvious and the rejection of claim 14 and its dependent claim 15 should be withdrawn.

Independent claim 16

The Office Action rejected claim 16 as obvious for the same reasons as claim 1. Applicant likewise traverses the rejection for the reasons given above in connection with claim 1. The rejection of claim 16, and its dependent claims 17 and 18, should be withdrawn.

Independent claim 19

The Office Action rejected claim 19 as obvious over the same references, citing FIG. 1 and paragraph 074 of Bar-On, and column 8, line 61 to column 9, line 15 of Banks in support of the rejection. The Office Action apparently argues that Bar-On's management system that provides recommended service areas according to the selection history of a particular calling device, described in paragraph 074, satisfies claim 19's recitation of "means for receiving group service definitions, including a terminal capability criterion, from an organizing terminal ...". The Office Action also argues that the paragraph beginning at column 8, line 61 of Banks teaches "qualifying terminals having previously met the group service definitions" as recited in claim 19. The rejection cannot be sustained.

With regard to the receiving means of claim 19, the service area selection *history* of a particular calling device, wherein Bar-On's AI-equipped management system monitors service areas frequently selected by the calling device, is not a "capability" of a mobile terminal. Furthermore, the receiving means of claim 19 specifies that the terminal capability criterion is received "from an organizing terminal" that is wirelessly coupled to the application server, which further distinguishes over the selection history information of Bar-On.

With regard to the "qualifying terminals" clause of claim 19, one must remember that the "group service definitions" that the qualifying terminals must have previously met include the "terminal capability criterion" discussed immediately above. Since no such criterion is taught in either Banks or Bar-On, the claim element is not taught and the rejection of claim 19 and its dependent claim 20 should be withdrawn.

Independent claim 21

The Office Action rejected claim 21 as obvious for the same reasons as claim 19. Applicant likewise traverses the rejection for the reasons given above in connection with claim 19. The rejection of claim 21 should be withdrawn.

Other claims

The rejections of dependent claims 2, 3, 6-9, 11-13, 15, 17, 18, and 20 have not been specifically addressed herein since they are rendered moot. It is to be understood that Applicant does not acquiesce to the Examiner's characterization of the art or Applicant's claimed subject matter, nor of the Examiner's application of the art to Applicant's claimed subject matter. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

CONCLUSION

In view of the foregoing, the application is submitted to be in condition for allowance, the early indication of which is earnestly solicited.

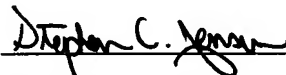
No fee is believed to be due by submission of this paper. If this belief is incorrect, authorization is given to charge Deposit Account No. 50-3581 (NOKM.075PA) any necessary fees for this filing.

If the Examiner believes it necessary or helpful, the undersigned attorney invites the Examiner to contact him to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: November 2, 2007

By: 
Stephen C. Jensen
Reg. No. 35,207